

11 JUN 2007



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WASHINGTON, DC 20004

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|---|---|----------|
| In re Application of | : | |
| James et al. | : | |
| Application No.: 10/576,936 | : | DECISION |
| PCT No.: PCT/GB04/04186 | : | |
| Int. Filing Date: 01 October 2004 | : | ON |
| Priority Date: 25 October 2003 | : | |
| Attorney Docket No.: 066079-5128 | : | PETITION |
| For: Process For Etching Metal And Alloy Surfaces | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 26 April 2007.

DISCUSSION

In a Decision mailed on 19 March 2007, the petition under 37 CFR 1.47(a) filed on 19 January 2007 was dismissed without prejudice because

Counsel refers to an accompanying "declaration by Amanda J. Collier" to show that Mr. Cottrell refused to execute the declaration. Ms. Collier states that, "On April 21, 2006, I sent the application with declaration and assignment to David Cottrell at his address of record in the company files..." for signature, followed by a "reminder" on 07 June 2006, but that she later learned that Mr. Cottrell "had moved." After learning that Mr. Cottrell had "moved," Ms. Collier states that she sent him further "reminder" letters, and that Mr. Cottrell "responded to the aforementioned letters by e-mail on September 1, 2006." However, it is not clear whether Mr. Cottrell was actually presented with an oath or declaration and a complete copy of this application, since it is not clear whether he received the correspondence sent to his previous address. Moreover, it is not clear whether a copy of this application was sent to him, since Ms. Collier's correspondence does not explicitly recite an application number; instead, it merely cites a case reference number which does not correspond to the present docket number of this application. Moreover, it is unclear whether Mr. Cottrell's email to Ms. Collier, dated 01 September 2006, evidences a "refusal" to execute the application. Rather, the email suggests that Mr. Cottrell did not understand his "interest in this area," suggesting that he believed himself to be "no longer required so I don't see what the issue is." This admits the possibility that Mr. Cottrell may have been willing to execute the declaration if he had been apprised of the reasons his participation was still relevant and necessary. For all of these reasons, the evidence of record does not presently establish a "refusal" within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition does not include an affirmative and explicit statement of Mr. Cottrell's last known address. Though the supporting documentation refers to at least two addresses for Mr. Cottrell, and though Mr. Cottrell is understood to be deceased, neither of these circumstances satisfies or obviates requirement (3). Nor does the reference in the petition to Mr. Cottrell's

"former residence" being listed in the declaration, since petitioner is not clearly referring to a "last known" address, and since the "Declaration of Amanda Collier" refers to more than one former address for Mr. Cottrell. To the extent that petitioner considers the address given in paragraph 21 of Ms. Collier's "Declaration..." to be Mr. Cottrell's "last-known" address, a statement to that effect by petitioner would be appropriate.

In response, petitioner has filed a "Supplemental Declaration of Amanda Collier" which confirms that Mr. Cottrell's address was the 12 Linksway address, and clarifies that the case reference number appearing on the correspondence she sent him at that address (SMC 60622/UST) corresponds to the instant U.S. national stage application. Ms. Collier further clarifies the context of Mr. Cottrell's 01 September 2006 email. It is noted that Mr. Collier's email indicates that he no longer resides in England, but it is clear that he received the correspondence in issue (including the copy of the application), and that the 12 Linksway address was his last address known to petitioner. Based on the totality of the showing now presented, it would be appropriate to conclude the Mr. Cottrell refused to execute this application within the meaning of 37 CFR 1.47(a).

DECISION

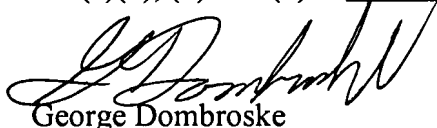
The petition under 37 CFR 1.47(a) is **GRANTED**.

The \$130.00 surcharge under 37 CFR 1.492(h) is being charged to counsel's Deposit Account No. 50-0310, as authorized by the instant petition.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor's last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **19 January 2007**.



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UNITED KINGDOM

In re Application of
James et al.
Application No.: 10/576,936
PCT No.: PCT/GB04/04186
Int. Filing Date: 01 October 2004
Priority Date: 25 October 2003
Attorney Docket No.: 066079-5128
For: Process For Etching Metal
And Alloy Surfaces


Dear Mr. Cottrell:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of a joint inventor. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (David COTTRELL) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/GB2004/004186) and was filed on October 1, 2004 in the names of David COTTRELL and Mark JAMES for the invention entitled PROCESS FOR ETCHING METAL AND ALLOY SURFACES. The national stage application number is 10/576,936 and has a 35 U.S.C. 371(c)(1), (2) and (4) date of January 19, 2007.